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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,214	03/31/2000	Jay S. Walker	00-006	9740

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WALKER DIGITAL  
2 HIGH RIDGE PARK  
STAMFORD, CT 06905

EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/540,214

Applicant(s)

WALKER ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,6-23,25-29,34-36,38,39,41,56,57,61,63,69-80,97 and 99-114 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6-23,25-29,34-36,38,39,41,56,57,61,63,69-80,97 and 99-114 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1, 6-23, 25-29, 34-36, 38, 39, 41, 56, 57, 61, 63, 69-80, 97 and 99-114 have been examined.

### ***Response to Amendment***

2. The Amendment filed on 2/2/06 is insufficient to overcome the prior rejection.

### ***Priority***

3. Applicant's claim for domestic priority is acknowledged. However, the application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for the independent claims of this application. Applicant's request for priority to US Patent Application 08/889,503 (now US Patent 6,249,772) is not granted. US Patent 6,249,772 does not disclose numerous features of the Applicant's independent claims. Therefore, because features are not adequately supported in the disclosure of the cited parent application, this application (09/540,214) does not receive a priority date to the cited parent applications 6,249,772.

Examiner notes that all features of the independent claims must be present in the disclosure of the parent application in order to receive priority to that application. However, the Applicant has been found to have support for the claims as presently written in the 6,754,636 Patent. Hence, the Applicant's Priority Date for the 09/540,214 application is 6/22/1999 which is the priority date of the 6,754,636 Patent.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 6-23, 25-29, 34-36, 38, 39, 41, 56, 57, 61, 63, 69-80, and 97, 99-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergh (6,112,186) in view of Von Kohorn (5,227,874) in view of Goddard (6,876,983) in view of Ojha (6,598,026).

Claims 1, 7, 10, 16-23, 25-29, 38, 39, 41, 56, 57, 61, 63, 69-80, and 97, 99-114: Bergh discloses a system and method for:

receiving from a customer an indication of a product category or a service category (col 3, lines 17-25; col 1, lines 24-32; col 11, lines 5-7; col 11, lines 49-53; col 27, lines 9-14).

Additionally, If a user can become more experienced in a particular domain, as Bergh discloses (col 11, lines 49-53), it is inherent that that user is selecting that domain more regularly. Bergh also discloses that the user can choose different product categories by selecting different websites (col 28, lines 5-11; col 28, lines 18-22). Bergh also discloses that user category and item selection in different categories can be interconnected (col 28, lines 10-15; col 28, lines 20-25; col 28, lines 49-53).

Bergh further discloses selecting for the customer one of the products in the product category or the services in the service category (col 27, lines 17-20; col 27, lines 27-30; col 27, lines 65-col 28, lines 2; col 1, lines 50-54).

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Bergh further discloses providing an indication of said selected one of said at least two products or said at least two services (col 27, lines 17-20; col 27, lines 27-30; col 27, lines 65-col 28, lines 2).

Bergh further discloses a retailer category (col 1, lines 24-32; col 3, lines 17-25) where the retailer category is restaurants, clothing stores, World Wide Web pages, etc.

Bergh further discloses that the user makes a purchase (col 27, lines 65-col 28, lines 2).

Bergh does not explicitly disclose selecting, for a customer, one of the products from a first product and a second product, where the customer had indicated the first product and the second product, and a willingness to purchase any one of the first product and the second product.

However, Von Kohorn discloses selecting, for a customer, one of the products from a first product and a second product, where the customer had indicated the first product and the second product, and a willingness to purchase any one of the first product and the second product (col 99, line 37-col 100, line 5).

Von Kohorn further discloses indicating an area of interest (col 98, lines 33-36).

Von Kohorn further discloses targeting user with differing incentives (col 104, line 65-col 105, line 3; col 105, lines 17-24).

Von Kohorn further discloses targeting information to select groups of users (col 78, lines 40-52).

Von Kohorn further discloses utilizing competitive advertising to induce purchasing (col 105, lines 45-52) and that advertising can be in the form of incentives or coupons (col 8, lines 40-44; col 100, lines 60-68).

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Von Kohorn further discloses that products from several sponsors can be provided as potential items of interest (col 83, lines 39-43).

Von Kohorn further discloses that the product can be a service or organization (col 100, lines 40-45) and that an organization can be a retailer (col 76, line 67-col 77, line 5).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Von Kohorn targeting user's based on items of interest for purchasing to Bergh's targeting user's based on items of interest and user making purchases. One would have been motivated to do this in order to allow flexible incentives for purchasing to be presented to users based on user interests.

Additionally, Von Kohorn discloses that the user selects item(s) that the user is interested in purchasing (col 99, lines 49-52). Note that the customer is presented a listing of many items that are available for purchase (col 99, lines 38-50) and that the user only selects the item(s) that the user is interested in purchasing (col 99, lines 49-52). Therefore, the user indicates a willingness to purchase at least one but not all of the plurality of products.

Von Kohorn also discloses selecting, for a customer, at least one of the products from a plurality of products (col 82, lines 20-55). Note that Von Kohorn's list includes all products for sale (col 82, lines 47-53) and that Von Kohorn selects for the customer product promotions for either or both of products the user selected and did not select as being interested in (col 82, lines 35-42).

Von Kohorn further discloses utilizing advertisements to entice a user to purchase a different or competing product from one the user would have normally selected (col 1, lines 45-55).

Von Kohorn further discloses the user selecting products, groups of products, competing products in different manners and forms (col 47, lines 5-15).

Additionally, Von Kohorn also discloses that the benefit is provided in exchange for the selecting (col 47, line 42-col 48, line 10; col 2, line 60-col 3, line 5; col 2, lines 49-53) and the benefit can be a prize, token, reward which can take many forms (col 11, lines 16-24; col 79, lines 19-25). Note that Von Kohorn discloses that a benefit can be awarded to the user for the act of selecting a product. And, note that the benefit can take many forms including a cash payment.

Bergh does not explicitly disclose the user selecting a category of products and then selecting a product in that category for the user.

However, Goddard discloses the user selecting a category of products and then selecting a product in that category for the user:

“(106) A Tender for a One of a Group of Products or a Tender for a Product  
Defined by a Specification:

(107) The logic behind this process is that in many cases a shopper knows the specification of the product he/she wants to purchase, but he is willing to buy one of a group of products which fulfill this desired specification. For example if a shopper wishes to purchase a color television set with a 20" screen the system will form an open tender which will be submitted to manufacturers or suppliers of televisions complying with this specification. These manufacturers can either be specified, in which case the shopper knows a head of time that the television is to be purchased from a manufacturer included within a group of manufacturers specified by either the system or the shopper, or alternatively manufacturers are

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not specified. The system will evaluate the offers and decide on the best offer in accordance with the specification of the group, following which the deal is finalized” (col 13, lines 24-41).

Goddard further discloses the user indicating an amount the user is willing to pay (col 1, line 64-col 2, line 32).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goddard user indicating a willingness to purchase one of a plurality of products in a product category to Bergh’s recommending one of a plurality of products in a product category and user making purchases. One would have been motivated to do this in order to better incite user purchasing.

Bergh does not explicitly disclose a penalty if the product is not purchased.

However, Ojha discloses a penalty if a user does not honor a commitment to make a purchase:

“(10) There are, however, some attendant disadvantages associated with allowing buyers to submit non-bidding bids. For example, if there are no consequences to the buyer for submitting a bid, many bids may be submitted by a single buyer or a small group of buyers solely for the purpose of manipulating the market for a particular product. Moreover, resources may be wasted by a seller in pursuing a proliferation of non-serious bids. As discussed above, one solution is to require that a buyer submit a credit card number before he may submit a bid, and further to assess some financial penalty against the buyer's credit card if the buyer abandons the negotiation. Unfortunately, this may serve as a barrier to entry for many buyers in that they are much less likely to conduct simultaneous negotiations with a number of merchants under these conditions (col 2, lines 25-40);



(50) Additionally, the negotiations described above have been described largely as a non-bidding process until after a mutually agreeable price has been found and the parties decide to consummate the deal. However, it will be understood that negotiations may be made partially or fully binding without departing from the scope of the invention. That is, a payment identifier such as, for example, a credit card or billing account may be requested before a party is allowed to negotiate. If the party attempts to terminate negotiations prematurely, some sort of penalty may be assessed to the identified account” (col 21, lines 30-40).

Ojha further discloses flexibility in the different utilizations of Ojha’s disclosure:

“(51) Finally, many of the embodiments of the present invention have been described in a context in which a transaction site acts as an intermediary between buyers and sellers. However, it will be understood that the scope of the present invention also encompasses negotiations, transactions, and other various features described herein when occurring directly between a buyer and a seller on, for example, the web site of the seller. These features include (but are not limited to) shopping lists, mutual exclusivity, request for quotes, buyer reputation, demand curve creation and use, block responses, bundle bid creation, cross-selling and all other aspects of the invention described above.

(52) Conceivably, any seller selling products at list prices on the Internet could get additional value by enabling negotiations and other related features as described herein. It is therefore important to note that the scope of this invention includes all of the features described herein, even where these features are enabled at the web sites of sellers who directly sell products to buyers. Therefore, the scope of the invention should be determined with reference to the appended claims” (col 21, lines 13-62).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Ojha's penalty for broken purchase commitments to Bergh's recommendation and purchase method. One would have been motivated to do this in order to better assure buyer reliability and buyer capability of making purchases.

Bergh does not explicitly disclose providing a discount to the user.

Also, Ojha further discloses providing a benefit or discount to the user:

“(17) Each buyer's reputation is made available to sellers on the site for use as they see fit. For example, a seller could choose to respond only to bids from buyers who have a reputation which is of a certain level. Alternatively, a seller could choose to respond unfavorably to such buyers, thus giving the buyer immediate feedback and incentive to adjust her bid accordingly. In addition, a seller could give preferential treatment, e.g., discounts, to buyers with very good reputations. Thus, buyers would tend to conduct transactions in a responsible manner to protect their reputations from being damaged and to receive preferential treatment (col 3, lines 44-54);

(29) Similarly, in interface 1310, if the bid-list spread is between 10 and 50%, the actions taken are to reduce the ask price by 10% and present the text message "We have a great deal for you--we can offer you a 10% discount." Finally, as shown in interface 1312, if the bid is within 10% of the list price, an acceptance message is transmitted to the bidder” (col 16, lines 22-28).

Also, Von Kohorn discloses providing a benefit or discount to the user:

“Inducements can take the form of printouts, such as monetary coupons, dispensed in homes of broadcast audience members who have responded to a task” (Abstract).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Ojha or Von Kohorn's benefit or discount provided to the user to Bergh's user making purchases and providing services to the user. One would have been motivated to do this in order to better incite user purchasing.

Claims 6 and 34: Bergh and Von Kohorn disclose a method as in claims 1 and 29, and Bergh further discloses that said indication of a product category including at least two products or a service category including at least two services is completed by at least one of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claims 8 and 35: Bergh and Von Kohorn disclose a method as in claims 7 and 29, and Bergh further discloses that said indication of said benefit is provided to at least one of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claims 9 and 36: Bergh and Von Kohorn disclose a method as in claims 7 and 29, and Bergh further discloses that said indication of said benefit is provided by at least one of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claim 11: Bergh and Von Kohorn disclose a method as in claim 10, and Bergh further discloses that said indication of a purchase is received from at least one of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claim 12: Bergh and Von Kohorn disclose a method as in claim 10, and Bergh further discloses that said indication of a purchase is received by at least one of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claims 13-15: Bergh and Von Kohorn disclose a method as in claim 1.

Bergh further discloses receiving a customer identifier and determining a customer identifier (col 28, lines 47-56).

Bergh further discloses a purchase (col 27, line 65-col 28, line 2) and making a payment (col 19, lines 6-16).

Bergh does not explicitly disclose a payment identifier, receiving a payment identifier, that said payment identifier is customer identifier.

However, Ojha discloses a payment identifier, receiving a payment identifier, that said payment identifier is customer identifier (col 1, lines 25-35 and throughout the Ojha disclosure).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Ojha's payment identifier to Bergh's purchase. One would have been motivated to do this because purchases can be efficiently tracked and completed utilizing payment identifiers.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1, 6-23, 25-29, 34-36, 38, 39, 41, 56, 57, 61, 63, 69-80, 97 and 99-114 have been considered but are not found persuasive.

On page 28-29 of the Applicant's Amendment dated 2/2/06, Applicant states that Goddard and Ojha are not valid prior art. As noted in the Priority section above, Applicant has been acknowledged as having a priority date supported by the 6,754,636 patent. Therefore, the Applicant has a priority date to 6/22/1999. However, the Ojha reference has a priority date to March 9, 1999 because of the Divisional Application and to January 25, 1999 because of the fully supporting Provision Application. Therefore, the Ojha reference predates the 6/22/1999 date and the Ojha reference is valid prior art against the Applicant's Application 09/540,214. Also, the Goddard reference has a priority date December 2, 1998. Note in the Certification of Correction page for the Goddard reference that the Goddard reference has a continuity chain that goes to PCT/IL99/00650 which has a priority date of December 1, 1999. And, the Goddard reference has a continuity chain that goes to the Provisional Application 60/110, 597. The Provisional Application 60/110, 597 has a priority date of December 2, 1998 which predates the Applicant's priority date of 6/22/1999. And, the Provisional Application 60/110, 597 supports the Examiner's citations made to the Goddard reference 6,876,983. See page 8 of the Provisional Application 60/110, 597 (page 8) to see how the Provisional Application supports the features relied upon from the Goddard reference. Hence, both the Ojha and Goddard references predate the Applicant's priority date of 6/22/99 and are, therefore, valid prior art.

The Applicant has presented no further arguments of substance in the Amendment dated 2/2/2006. Hence, the Applicant's Arguments have been fully responded to. Also, the Rejection above has been modified to address the changes made in the Applicant's claims dated 2/2/2006.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the

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specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Giovannoli (2006/0015413), Ross (6,993,572), Gerbaulet (5,544,040), and Van Horn (6,604,089) disclose indicating selecting a product from a product category that is available for purchase.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur Duran  
Primary Examiner  
3/2/06